

REMARKS

In accordance with the foregoing, claims 9 and 11 have been amended to correct apparent typographical errors without narrowing the scope therein as would be understood by one of ordinary skill in the art. Moreover, while the Examiner lists claims 1-32 as pending, it is respectfully submitted that claim 2 was previously cancelled without prejudice or disclaimer. As such, claims 1 and 3-32 are pending and under consideration. No new matter is presented in this Amendment.

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION AND ISSUANCE OF CORRECTED OFFICE ACTION

Additionally, the Examiner asserts on page 9 of the Office Action that the amendment of the claims necessitated the new rejection. However, it noted that claims 9 and 11 were made independent in the Amendment of August 30, 2007. As such, the Examiner's new rejection of claims 9 and 11 based upon obviousness-type double patenting cannot be made final as these claims were not amended in a manner which necessitated the obviousness-type double patenting rejection. MPEP 706.07(a). Therefore, it is respectfully requested that the Examiner both withdraw the finality of the Office Action mailed March 17, 2008, and issue a corrected non-Final Office Action. See, MPEP 706.07(d).

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

Applicant requests entry of this Rule 116 Response because the amendments of claims 9 and 11 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised relative to indicated allowability of claims 9 and 11 in the Office Actions of October 23, 2006, April 16, 2007, and/or June 4, 2007; and the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "[a]ny amendment that will place the application either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining

Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

OBVIOUSNESS TYPE DOUBLE PATENTING:

On pages 2-5 of the Office Action, the Examiner provisionally rejects claims 1-32 on the ground on nonstatutory obviousness-type double patenting in view of selected claims of copending Application Nos. 10/776,343 and 11/430,868, and rejects claims 1, 4-9, 12 and 17 on the ground of nonstatutory obviousness-type double patenting in view of selected claims 1-12 of U.S. Patent No. 6,934,236. Without admission as to the indistinctiveness of the claims, in view of the enclosed terminal disclaimer, it is respectfully requested that the Examiner reconsider and withdraw the rejection.

Additionally, while not required by the Examiner, please note that the enclosed Terminal Disclaimer further includes U.S. Patent Application No. 11/429,967.

REJECTIONS UNDER 35 U.S.C. §103:

On pages 6-7 of the Office Action, the Examiner rejects claims 1, 24, and 32 under 35 U.S.C. §103(a) in view of Ko ('054), ('493), or ('605) and Tasaka et al. The rejections are respectfully traversed and reconsideration is respectfully requested.

As a point of clarification, the Examiner newly rejects claims 1, 24, and 32 in view of Ko ('054), ('493), or ('605) and Tasaka et al., but does not identify these references or list the same in a PTO Form 892 to ensure that these references are clearly made of record. It is respectfully requested that the Examiner ensure that these references are indicated in a PTO Form 892 to clarify the record.

However, from our review of copending Application No. 10/766,343, it appears that the Examiner is relying on the same rejection and references made in copending Application No. 10/766,343. As such, it is assumed that the rejection is of Ko (U.S. Patent No. 7,046,605); Ko (U.S. Patent No. 7,142,493); or Ko (U.S. Patent No. 6,868,054) (collectively, the Ko references) and in view of Tasaka et al. (U.S. Patent 7,068,579). If these assumptions are in error, it is respectfully requested that the Examiner withdraw the rejection as the Examiner has not made a *prima facie* case for anticipation or obviousness since the action lacks any meaningful explanation for the rejection, and issue a corrected Office Action clearly indicating the correct references on which the rejection is based.

With respect to the Examiner's obviousness rejection under 35 U.S.C. § 103(a) rejection, it is noted that the Ko references do not qualify as prior art under 35 U.S.C. § 103(a). Under 35 U.S.C. §103(c), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section [§ 103] where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” The Ko references are prior art only under 35 U.S.C. § 102(e), as the issue date for each of the Ko references is later than the filing date of the instant application. The present application was subject to an obligation of assignment to Samsung Electronics, Ltd. on or before the filing date of the instant application. The Ko references relied upon by the Examiner were assigned to Samsung Electronics Ltd. prior to the filing date of the instant application. As a result, 35 U.S.C. § 103(c) bars the use of the Ko references as prior art under 35 U.S.C. § 103(a). Accordingly, since the Examiner does not rely upon Tasaka et al. as disclosing the remaining features of the claims, the rejection of claims 1, 24 and 32 under 35 U.S.C. § 103(a) in view of the Ko references and/or Tasaka et al. cannot be sustained.

On page 7 of the Office Action, the Examiner rejects claim 3 under 35 U.S.C. §103(a) in view of the art as applied to claim 1 above, and further in view of Sasa et al. (U.S. Patent No. 6,628,595) starting at col. 8 line 39 with respect to the DVD Specification, July version 1.9. The rejections are respectfully traversed and reconsideration is respectfully requested.

Since the Examiner does not rely upon Sasa et al. or the DVD Specification as curing the above noted deficiencies of the Ko references and/or Tasaka et al. as applied to claim 1, and since the Ko references are not available for use in obviousness rejections due to the provisions of 35 U.S.C. §103(c), it is respectfully requested that the Examiner reconsider and withdraw the rejections.

On page 7 of the Office Action, the Examiner rejects claims 4-8 and 12-16 under 35 U.S.C. §103(a) over the art as applied to claim 1, and further in view of Lim (U.S. Patent No. 6,330,215). The rejections are respectfully traversed and reconsideration is respectfully requested.

Since the Examiner does not rely upon Lim as curing the above noted deficiencies of the Ko references and/or Tasaka et al. as applied to claim 1, and since the Ko references are not available for use in obviousness rejections due to the provisions of 35 U.S.C. §103(c), it is respectfully requested that the Examiner reconsider and withdraw the rejections.

On pages 7-8 of the Office Action, the Examiner rejects claim 17 under 35 U.S.C.

§103(a) over the art as applied to claim 12 above, and further in view of Miyake et al. (U.S. Patent No. 6,580,684). The rejections are respectfully traversed and reconsideration is respectfully requested.

Since the Examiner does not rely upon Miyake et al. as curing the above noted deficiencies of the Ko references and/or Tasaka et al. as applied to claim 12, and since the Ko references are not available for use in obviousness rejections due to the provisions of 35 U.S.C. §103(c), it is respectfully requested that the Examiner reconsider and withdraw the rejections.

On page 8 of the Office Action, the Examiner rejects claims 18-23 under 35 U.S.C. §103(a) in view of the Ko references in view of Miyake et al. Since the Examiner does not rely upon Miyake et al. as disclosing all of the features of claims 18-23 without the Ko references, and since the Ko references are not available for use in obviousness rejections due to the provisions of 35 U.S.C. §103(c), it is respectfully requested that the Examiner reconsider and withdraw the rejections.

On pages 8-9 of the Office Action, the Examiner rejects claims 24-31 under 35 U.S.C. §103(a) in view of the Ko references, Tasaka et al. and Miyake et al. Since the Examiner does not rely upon Tasaka et al. and Miyake et al. as disclosing all of the features of claims 24-31 without the Ko references, and since the Ko references are not available for use in obviousness rejections due to the provisions of 35 U.S.C. §103(c), it is respectfully requested that the Examiner reconsider and withdraw the rejections.

CLAIM OBJECTION:

On page 9 of the Office Action, the Examiner objects to claim 18 as being a substantial duplicate of claim 3. However, it is noted that claim 3 recites compatibility information in addition to an optimal writing pattern. In contrast, claim 18 does not recite the use of an optimal writing pattern or that the information is compatibility information. As such, it is respectfully submitted that the claims are not duplicative of each other, and that the Examiner reconsider and withdraw the objection.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

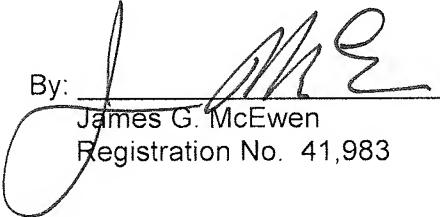
If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: May 16, 2008

By:


James G. McEwen
Registration No. 41,983

1400 Eye St., N.W.
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510